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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Bahram G. Kermani**

Serial No.: **09/487,522**

Filed: **January 19, 2000**

For: **METHOD AND SYSTEM FOR ABSTRACTING ELECTRONIC DOCUMENTS**

Examiner: **Rachna Singh**

Group Art Unit: **2176**

Confirmation No.: **3260**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

### REPLY APPEAL BRIEF UNDER 37 C.F.R. 41.41

Pursuant to 37 CFR 41.41, Applicant hereby submits this Reply Appeal Brief. The Reply Appeal Brief is being timely submitted under 37 CFR 41.41(a)(1), the date of the Examiner's Answer being December 14, 2005. The reply appeal brief is being submitted in triplicate.

Respectfully Submitted,

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## I.   Status of Claims

Claims 1, 3-9, 11-16, 18, 19, 22-23, 25-26, 28-32 and 37-42 are pending and rejected.

## II.   Argument

Claims 1, 3-9, 11-16, 18, 19, 22, 23, 25, 26, 28-32 and 37-42 have been rejected as being obvious from Grefenstette in view of Katariya. In the Appeal Brief, Applicants argued that the Examiner's proposed combination of Grefenstette and Katariya does not allow <u>both</u> (1) the selection between multiple versions to be created from the electronic document <u>and</u> (2) that a version specifically selected by the user can be created using a customized set of instructions comprising pre-assigned weights to portions of the electronic document, as required by Applicant's independent claims. In the Examiner's Answer, the Examiner argues that Applicants' contentions are unsupported. Applicants respectfully disagree as set forth below.

### A.   Claims 1, 3-9, 11-16, 18, 19, 22, 23, 25, 26, 28-32 and 40-42

Independent claim 1 recites two features that are closely related and intertwined: (a) prompting a user <u>to select an abstracted version</u> of the electronic document to be created <u>from a plurality of abstracted versions available to be created</u>; and (b) responsive to a selection by the user of the abstracted version to be created, <u>creating the selected abstracted version</u> of the electronic document <u>by executing a set of instructions</u> corresponding to the electronic document, wherein <u>the instructions are, before said abstracted version is selected by the user, customized to the electronic document,</u> the <u>customization</u> comprising a plurality of weights pre-assigned to respective portions of the electronic document to <u>enable creation of said plurality of abstracted versions</u>. (emphasis added) As highlighted by the underlined sections, claim 1 clearly requires that the user be able to select from a plurality of abstracted versions of an electronic document that can be created and, in the creation of the selected abstracted version, a customized set of instruction is used that is capable of creating the plurality of abstracted versions of the electronic document. As has been argued previously, these customized instructions must not only be able to create the different versions of the electronic document, but must also exist before the user makes his or her selection.

While Grefenstette may allow its user to create different versions of a document, Grefenstette fails to teach or suggest (i) instructions that are, before said abstracted version is

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selected by the user, customized to the electronic document, (ii) the customization comprising a plurality of weights pre-assigned to respective portions of the electronic document or (iii) weights pre-assigned to respective portions of the electronic document to enable creation of said plurality of abstracted versions. Applicants submit that these points have been conceded by the Examiner.

Turning to Katariya, Katariya teaches a weighting scheme, but does not teach (i) selecting an abstracted version of the electronic document to be created from a plurality of abstracted versions available to be created, or (ii) executing a set of instructions corresponding to the electronic document, wherein the instructions enable creation of a plurality of abstracted versions. Applicants again submit that these points have been conceded by the Examiner.

Being that Katariya does not teach an abstraction routine <u>that can create more than one version of an electronic document using pre-assigned weights</u>, and Grefenstette does not teach a pre-assigned weight based set of instructions, the combination of Grefenstette and Katariya <u>cannot</u> teach applicants claimed method.

Perhaps the failure of the Office to set forth a *prima facie* case of obviousness is better understood as a lack of a "reasonable expectation of success" that the cited combination will achieve Applicants' claimed invention. MPEP 2142 (setting forth the requirements for *prima facie* case of obviousness). Katariya teaches a weighting scheme, but not an accompanying algorithm or scheme that allows for creation of a plurality of different versions of an electronic document using the weighting scheme. Grefenstette allows its users to select different abstraction levels of a document, but is completely void of any teachings regarding (i) abstraction instructions that are customized to the electronic document before selection of the versions to be created and (ii) abstraction instructions including pre-assigned weights.

Trying to fill the holes in Grefenstette's teachings with those of Katariya's is analogous to adding fractions without a common denominator – it does not work. There is no reasonable expectation that one of ordinary skill, given the teachings of Katariya, which enable only creation of a <u>single</u> abstracted version of a document using a weighting scheme, could modify Grefenstette's non-customized, part-of-speech abstraction routine to provide a method and system where the user can select between <u>multiple</u> versions of an electronic document available to be created and where the selected version is created by executing a set of instructions that are, before said abstracted version is selected by the user, customized to the electronic document, the

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customization comprising a plurality of weights pre-assigned to respective portions of the electronic document to enable creation of said plurality of abstracted versions.

From the foregoing, the combination of Grefenstette and Katariya does not teach or suggest the prompting and creating steps of claim 1. It follows that independent claim 1, and independent claims 9, 16 and 23, which recite features that parallel claim 1, are not obvious from Grefenstette in view of Katariya, and are therefore allowable over the art of record. It is submitted that claims 3-8, 11-15, 18-19, 22, 25-26, 28-32 and 40-42, which depend from the independent claims, are also allowable for at least the reasons set forth above.

### B.      Claims 37-38, 39 and 41

It is submitted that Claims 37-38, 39 and 41 are independently allowable as set forth in the Appeal Brief.

Claims 37 and 38 also recite features similar or identical to independent claim 1 discussed above, and are, therefore, allowable for at least the reasons set forth above.

Claims 39 and 41 depend from Claims 1 and 23, and are, therefore, allowable for at least the reasons set forth above in connection therewith.